

## REMARKS

This application has been reviewed in light of the Office Action dated September 19, 2008. Claims 1-4, 6, 8-12, 19-22 and 24-30 are presented for examination, of which Claims 1, 11, 19 and 29 are in independent form. Claims 1, 11, 19, and 29 have been amended to define still more clearly what Applicant regards as his invention. Favorable reconsideration is requested.

Claims 1-4, 6, 8-12, 19-22 and 24-30 were rejected under 35 U.S.C. § 103(a) as being obvious from U.S. Patent 6,466,329 (Mukai) in view of U.S. Patent Application Publication 2002/0170973 (Teraura).

Applicant believes that the general nature of the aspects of the invention that are set out in the present independent claims, and the prior art applied against the claims, have been adequately discussed in previous papers, and does not consider it necessary to repeat that discussion in full. Applicant has amended the independent claims to make clearer the feature that in the database, in accordance with an image forming operation for an image relating to desired subject data, first identification information read from an RFID tag of a first recording medium on which the image relating to the desired subject data is formed in the image forming operation, and the desired subject data are stored in association with each other. (To this end, the recitation of the database states that the database means, “in accordance with an image forming operation for an image relating to desired subject data by the image forming means, stores first identification information, which is read by the detecting means from the RFID tag of a first recording medium on which the image relating to the desired subject data is *formed in the image forming operation*, and the desired subject data in association with each other [emphasis added]”).)

Applicant also stresses that the apparatus retrieves the subject data corresponding to the first identification information read from the RFID tag of the first recording medium on which the image relating to the desired subject data is formed, from plural subject data stored in the database, at a timing different from the image forming operation for the image relating to the desired subject data on the first recording medium, so that in accordance with a retrieval result, an image relating to the subject data corresponding to the retrieved first identification information is formed on a second recording medium already having the RFID tag different from the first recording medium.

That is, the apparatus of Claim 1 is not recited as having any means by which it could print ID information on a recording medium; rather, it reads the ID information from the RFID tag arranged on the recording medium in advance, so that the read ID information is stored in the database in association with the data subjected to the image forming operation. This is advantageous in that, by virtue of this feature, an apparatus according to Claim 1 is not required to manage the ID information to create new ID information.

Applicant strongly believes that the above-described feature of database means of Claim 1 is not taught or suggested by anything in *Mukai* and *Teraura*, taken either separately or together. The Office Action appears to assert that the present invention (at least as previously claimed) could have been easily attained by modifying *Mukai* to replace *Mukai*'s bar code with the RFID tag of *Teraura*. Without addressing whether the Examiner's analysis and application of the prior art are correct in all respects, Applicant strongly believes that nothing in those documents could have led a person of merely ordinary skill to an apparatus having the database means recited in Claim 1, in which the

database means is formed when the data is subjected to the image forming processing, *thereby* associating the ID information read from the RFID tag arranged on the recording medium with the data formed thereon.

Moreover, it should be noted that even if the *Mukai* system itself generates the bar code to print it in master form printing, nothing in that patent is seen to relate in any way to reading the bar code in the master form printing, and indeed *Mukai* seems to contemplate that the printed bar code is read only when the master-form *printed image* is *copied* onto another recording medium. That is, the *Mukai* system is required to generate the bar code (i.e., ID information) for the master form printing by itself and then manage the large amount of generated ID information to generate new ID information for another master form printing. This is a large processing burden, which is avoided by the apparatus of Claim 1.

Applicant understands that in the analysis in the Office Action, *Teraura* is relied upon only for a recording medium having an RFID tag that stores information, and that the Examiner considers that this feature, if added to the *Mukai* teaching, would have led a person of ordinary skill to the structure of the apparatus of Applicant's Claim 1. For the foregoing reasons, however, this conclusion is not believed to be tenable. That is, even if such modification of *Mukai* were made by a person of ordinary skill, the result would in fact not have the database means recited in Claim 1.

Applicant therefore submits that Claim 1 is allowable over *Mukai* and *Teraura*, taken alone or in combination.

With regard to independent Claim 11, Applicant points to the control means, and submits that nothing in *Mukai* and *Teraura*, whether taken separately or in the

proposed combination, would teach or suggest control means “that retrieves subject data corresponding to the identification information read from the RFID tag of a first recording medium *on which an image corresponding to the subject data is formed by the image forming means, by the detecting means from plural subject data stored in a database that stores the identification information read from the RFID tag of plural recording medium on which the images corresponding to the subject data is formed respectively and the plural subject data in association with each other* and controls the image forming means to form an *image relating to the retrieved subject data on a second recording medium having the RFID tag different* from the first recording medium [emphases added]”.

Independent Claims 19 and 29 are method claims corresponding to apparatus Claims 1 and 11, respectively, and are therefore also believed to be allowable for the same reasons.

A review of the other art of record has filed to reveal anything which, in Applicant’s opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and allowance of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

/Leonard P Diana/  
Leonard P. Diana  
Attorney for Applicant  
Registration No. 29,296

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200

FCIS\_WS 2641063v1